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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,928	08/27/2003	Benjamin T. Gomez	47079-0228	6114

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EXAMINER

KARKHANIS, AASHISH

ART UNIT	PAPER NUMBER
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3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/649,928	GOMEZ ET AL.	
	Examiner	Art Unit	
	Aashish Karkhanis	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. Claim 20 discloses a number of determination steps, but does not provide any useful or tangible result from the determination steps. Therefore, since no useful or tangible result is disclosed from an abstract determination, Claim 20 does not contain statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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2. Claims 1 – 10, 13 – 19 and 21 – 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Frohm et al. (U.S. Patent 6,159,095).

Regarding Claims 1, 8, 13 – 14, 19 and 23, Frohm discloses a gaming machine having an improved game display including a plurality of extendable displays each having an indicium, the extendable displays further having a first position out of the field of view of a player and a second position in the field of view of a player (col. 2, lins. 41 – 50), a drive mechanism selectably engageable to each of the plurality of extendable displays for moving the extendable display in a first direction from the first position to the second position (col. 2, lins. 42 – 45) and for moving the extendable display in a second direction from the second position to the first position, and a central processing adapted to select one of the plurality of extendable displays and further adapted to signal the drive mechanism to translate the selected extendable display between the first position and the second position, and moving the extendable display in a second direction to return the extendable display to the first position (col. 5, lins. 38 – 40; where a deal option resets the game to the original state where no boards are popped up and extended). Frohm also discloses a display having a first obscured position, a second partially viewable position, and a third fully viewable position, and a method for translating between said positions as described above (col. 2, lins. 40 – 45; where a pop-up occurs in a cash register like fashion, including a middle position between obscured and displayed).

Regarding Claims 2 – 3 and 15 – 18, Frohm discloses a gaming machine wherein the game display has an aperture for allowing the player to view the extendable

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display in the second position, and the first position is behind an obstruction (col. 2, lins. 48 – 50; where a card is viewed through a simulated aperture on a touch-screen and is shown when touched).

Regarding Claims 4 – 5, 9 – 10 and 21 – 22, Frohm discloses a gaming machine wherein the drive mechanism rotates the extendable display between the first position and the second position, and linearly translates the extendable display between the first position and the second position (col. 2, lins. 48 – 50; where an electronic touch screen is used to simulate mechanical movement of an extendable display to perform an identical function).

Regarding Claim 6, Frohm discloses a gaming machine wherein the extendable display is a flat-panel display for displaying the indicium (col. 2, lins. 48 – 50).

Regarding Claim 7, Frohm discloses a gaming machine wherein the extendable display is a scroll mechanism having a plurality of indicia being individually selectable (col. 5, lins. 8 – 11; where a plurality of game boards in a stack may be selected and extended).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frohm et al. (U.S. Patent 6,159,095).

Regarding Claims 11 – 12, Frohm discloses a gaming machine wherein the drive mechanism includes a plurality of shafts concentrically oriented or solenoid valves, and a plurality of motors, each of the plurality of motors adapted to drive one of the plurality of shafts or valves (col. 9, lins. 26 – 33; where mechanical reels with symbols affixed are stopped, which may inherently be driven by motors or solenoids as is well known in the art) but does not disclose shafts or valves connected to an extendable display. However, Frohm discloses a touch-screen used to simulate an extendable display, causing an identical outcome as a plurality of shafts being connected to at least one extendable display (col. 2, lins. 48 – 50). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the electronic extendable display of Frohm with an electromechanical display and mechanism in order to provide a more old-fashioned and authentic gaming experience for a player.

Response to Arguments

4. Applicant's arguments have been fully considered but they are not persuasive.

Applicant maintains that Claim 20 is directed to statutory subject matter because it depends from a statutory claim. However, Claim 20 discloses only determination means, which, as discussed above, does not provide a tangible result. Even though Claim 20 depends from a statutory claim, it is itself non-statutory.

Applicant also maintains that the claimed invention distinguishes over the prior art because Frohm does not disclose a mechanical implementation of the game as discussed above. The examiner respectfully disagrees. Frohm does state that the disclosure "shall be understood herein to encompass video, as well as mechanical

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implementations" (col. 10, lins. 12 – 16), including specific mechanical devices for extending and rotating objects into view, such as solenoids or concentrically oriented shafts which use a mechanical system to provide substantially identical game operation and result.

Applicant further maintains that Frohm does not disclose an extendable display that is hidden from the player, or an aperture for viewing a game. However, as discussed above, Frohm does disclose a game element that is hidden from the player's view as a stack of cards, and where a card will extend into the display area and be visible to a player. This card object is hidden from a player because card information that distinguishes the card from others is not visible, and is only revealed to the player when the card is extended into a viewable area from behind other cards. The card is hidden, and not partially in the field of view because no information may be read from the card. Frohm also discloses a display screen aperture which allows a player to view an extendable display during a game.

Applicant also maintains that the claimed invention distinguishes over the prior art because Frohm does not disclose a rotating extension, and that a rotating extension is "completely different" than a sliding extension. The examiner respectfully disagrees. Rotating and sliding are both methods of generically exposing an object to a player, and both provide an identical game function, of showing a hidden game object to a player.

Finally, Applicant maintains that the claimed invention distinguishes over the prior art because Frohm does not disclose three distinct positions: hidden, partially hidden,

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and visible. However, as discussed above, where a cash-register style pop up includes a partially hidden view between a hidden and visible view.

For the reasons given above, claims 1 – 23 stand rejected.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aashish Karkhanis whose telephone number is (571) 272-2774. The examiner can normally be reached on 0800-1630 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ARK

A handwritten signature in black ink, appearing to read "Corbett B. Coburn", with a stylized flourish at the end.

**CORBETT B. COBURN
PRIMARY EXAMINER**